

which stores a list of possible symbols, a microprocessor to select symbols from the memory, a first switch to initiate game play and a second switch to allow for replacement of selected symbols. In one preferred embodiment, one can choose a symbol for immediate replacement by simply touching that symbol on the touch screen.

Alternatively, one can choose multiple symbols for replacement by touching those symbols and then touching an instruction button, such as a "spin" button, to actuate the replacement of all those symbols at once. In a further embodiment, both the symbols and their background colors can be replaced to add further variability and enjoyment to the game.

2. The Cited Art Distinguished

Claims 1-13 and 15-17 have again been rejected under 35 U.S.C. § 103(a) as being obvious over Dabrowski's U.S. Patent No. 5,356,140 ("Dabrowski patent") in view of Manship's U.S. Patent No. 5,393,061 ("Manship patent"). As noted by the Examiner, the Dabrowski patent discloses a video *poker* game. In the Dabrowski poker game, two poker hands are simultaneously dealt with one hand superimposed upon the other. The player then chooses which hand to play using the "First Hand" or "Second Hand" buttons on the middle of Dabrowski's console and then "the unselected hand is voided or removed from use" (see, Dabrowski patent, Abstract and col. 5, lns. 7-17).

Applicant's invention is not directed to a video poker game, but rather a variation of the popular electronic slot machine. To make this point clear, Applicant has stated in each of his claims 1-30 that the monitor displays a plurality of symbols "arrayed in separate boxes of multiple symbol columns and rows" and stated in claims 31-36 that the monitor displays a plurality of symbols "arrayed in multiple symbol columns and rows."

The Dabrowski video poker game, like other video poker games, does not have a plurality of symbols "arrayed in multiple symbol columns and rows," much less in "separate boxes" in these multiple symbol columns and rows (see, claims 1-30). Instead, Dabrowski shows only a single row of superimposed cards at the beginning of the game

E

which quickly becomes simply a single row of individual cards as the game is played. The Examiner does not dispute this point and, indeed, concedes that "Dabrowski lacks disclosing the card symbols being arrayed in multiple rows" (Office Action, p. 2).

To show the existence of a game in which symbols are displayed in multiple rows and columns, the Examiner cites the Manship patent. For his part, Applicant does not dispute that electronic slot machine games, of the type shown in the Manship patent, have been in use for many years. What Applicant does dispute is that, prior to Applicant's invention, electronic slot machine games were known which allowed the type of individual symbol replacement capabilities disclosed and claimed by Applicant (see, Jan. 10, 2001 Dietz Decl., ¶ 2). The Manship patent certainly fails to disclose any such individual symbol replacement capabilities. Moreover, neither the Examiner for Applicant's issued patent, U.S. Patent No. 5,704,835, nor the present Examiner has been able to find any electronic *slot machine* prior art reference with such disclosure.

In the "Examiner's Response to Applicant's Remarks," the Examiner argues that Applicant's claims covering a range of replacement symbols from "none to all" are unpatentable because they suggest "that there could be situations where none of the symbols are replaced by the player, which is typical of slot machines with multiple columns and rows of symbols" (Office Action, p. 6). The difference between Applicant's invention and these prior art slot machines, though, is that the prior art slot machines gave the player *no choice*. In these prior art slot machines, the game was entirely one of chance which required the player to live with all the symbols the machine initially chose. By contrast, by introducing the concept of choice, Applicant has created a game of skill in which the player can use his or her intelligence to try to improve the symbols initially chosen by the machine. In appropriate cases, this use of intelligence choice might result in the player deciding that the machine has satisfactorily chosen an initial group of symbols and, as such, the best course is to avoid replacing any of them.

Given the enormous popularity of slot machine gaming, if it were so "obvious" to add individual symbol replacement capability to an electronic slot machine

E

game, it would have been done long before Applicant's invention. See *In re Dembiczak*, 175 F.3d 994, 999 (Fed.Cir. 1999)("the very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher"). The fact that there is no such prior art and Applicant's competitors have now been quick to copy Applicant's invention provides strong "secondary consideration" support for a finding of non-obviousness (Jan. 10, 2001 Dietz Decl., ¶ 2-4). *In re Beattie*, 974 F.2d 1309, 1313 (Fed.Cir. 1992)(secondary consideration evidence "may be sufficient to overcome a prima facie case of obviousness").

Nonetheless, since prosecution of the rejected claims appears to be deadlocked because of the Examiner's concerns about the "from none to all" claim limitation, Applicant has added further limitations to the rejected claims which, to Applicant's knowledge, are missing from both the Dabrowski and Manship patents, namely use of a touch screen monitor. Support for these touch screen monitor limitations can be found in Applicant's specification at, among other places, page 4, lines 3-6; page 7, line 14-34 and page 11, lines 16- page 12, line 4.

In the context of Applicant's game, a touch screen monitor makes it easy and enjoyable for the player to choose symbols for replacement. For example, the player can be allowed to touch a symbol or its box on the touch screen and have that symbol immediately replaced (see, claim 16). Alternatively, the player can be given the opportunity to touch multiple symbols or their boxes and, when satisfied that the right symbols have been chosen, touch an instruction button, such as a "spin" button, to actuate the replacement of those symbols (see, claims 15). If, as another alternative, the player is happy with the symbols initially drawn, he or she can so indicate by touching a "stand" type of instruction on the touch screen (see, claims 10, 28). To help the player keep track of the symbols chosen for replacement, the touch screen box can light up when the player designates its symbol for replacement (see, claims 9 and 27). If the player makes a mistake, he or she can touch a lit up box or its symbol a second time to undesignate that symbol (see, claim 12).

E

While Applicant does not claim to have invented the touch screen monitor *per se*, Applicant strongly submits that he has invented a novel and unobvious variation of the popular slot machine game which makes inventive use of a touch screen monitor. For these reasons, the Examiner's proposed combination of the Dabrowski and Manship patents would not render as "obvious" the subject matter of Applicant's rejected claims.

Claims 18-19 have again been rejected under 35 U.S.C. § 103(a) as being obvious over the Dabrowski patent in view of either the Manship patent or Bennett's U.S. Patent No. 6,056,642 ("Bennett patent"). With respect to the Dabrowski patent, the Examiner acknowledges that the Dabrowski patent lacks disclosure of allowing the player to select background colors for replacement. The Manship patent discloses a slot machine game having display colors. In a so-called "Fever Mode," Manship's display colors are enhanced and the payout table is changed (see, col. 5, lns. 13-41 and col. 7). In its Abstract, the Bennett patent discloses that when a certain combination of numerical symbols appears after the only spin (e.g., three 7's), the slot machine can then choose to backlight those symbols with different colors (e.g., red, white or blue) and change the payout depending on the backlit colors. Like other common slot machines, there is no provision in either the Manship nor the Bennett patents for allowing the *player* to select one or more symbols or colors for replacement after the initial spin. As such, both Manship's and Bennett's slot machines are entirely games of chance, whereas Applicant's respin slot machine involves an important element of skill (i.e., choosing which slot machine symbols or colors to replace). Moreover, like the Dabrowski and Manship patents, there is no disclosure in the Bennett patent of using a touch screen monitor in the way now set forth in claims 18 and 19. For these reasons, neither the Manship nor the Bennett patents provide the claimed disclosure missing from the Dabrowski patent.

Claims 20-30, 32, 34 and 36 have been rejected as being unpatentable over the Dabrowski patent or Heidel's U.S. Patent No. 5,342,047 ("Heidel patent") in view of the Manship patent. The deficiencies in the Dabrowski and Manship patents have already been discussed. Contrary to the Examiner's position, the Heidel patent disclosure proves,

E

if anything, that Applicant's slot machine respin invention is *not* obvious. As noted by the Examiner, the Heidel patent discloses a typical video poker game with a *single* row of gaming cards, one which allows cards to be selected for replacement (i.e., by pressing buttons 32a-32e). The Heidel patent also discloses a video slot machine game in Fig. 2a. In describing this video slot machine game, Heidel parrots the conventional wisdom in the art prior to Applicant's invention that *one cannot have a respin capability on an electronic slot machine game*:

“When a game other than poker, *such as the slot machine game of FIG. 2a*, is selected by the player, the computer 50 is programmed to not accept inputs from the control button circuit 74. *Touching the game control buttons 32a-32e will therefore have no effect on the game*” (Heidel patent, col. 3, lns. 43-47; emphasis added).

Since the Heidel patent strongly teaches away from Applicant's invention, it is clear that Heidel cannot be combined with Dabrowski and/or Manship to render Applicant's claims 20-30, 32, 34 and 36 as “obvious.”

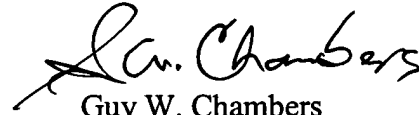
Finally, Applicant thanks the Examiner for noting that claims 31, 33 and 35 are allowable in their present form.

E

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (415) 576-0200.

Respectfully submitted,



Guy W. Chambers
Reg. No. 30,617

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Tel: (415) 576-0200
Fax: (415) 576-0300
GWC:lcb
SF 1452686 v1

E